UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,896	07/12/2001	Ulrich Rosenbaum	DT-4009	2006

30377 7590 06/05/2003

DAVID TOREN, ESQ.
SIDLEY, AUSTIN, BROWN & WOOD, LLP
787 SEVENTH AVENUE
NEW YORK, NY 10019-6018

EXAMINER
TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,896	Applicant(s) ROSENBAUM, ULRICH	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-10,12 -14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-10,12-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This Office action is in response to the amendment filed March 17, 2003 in which claim 7 was amended and claims 13 and 15 were added. It should be noted that claim 15 has been renumbered as claim 14.

It is noted that Applicant has requested a translation of CN 1206039. A translation of the document will be forwarded to Applicant upon receipt of the translation from the USPTO translation branch.

Claim Rejections - 35 USC § 103

1. Claims 7-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1206039.

CN teaches a fuel gas comprising of 0-98% dimethyl ether, 0-98% propane or propylene, <30% butane and a deodorizer as required (see abstract in its entirety). CN teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, CN differs from the claims in that it does not specifically teach that all of the claimed components are present in the composition. However, because CN teaches that up to 98% of dimethyl ether, propane or propylene may be present in the composition, this teaching suggests that all of the components may be present in the composition. Also, it is well settled that in the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art a prima facie case of obviousness exists. *In re Wertheim*, 191 USPQ 90 (CCPA 1976).

In the second aspect, CN differs from the claims in that it does not specifically teach the presence of isobutane in the composition (claims 9 and 10). However, it would have been obvious to one of ordinary skill in the art to have used isobutane because CN broadly teaches butane and this general teaching encompasses the isomers of n-butane, such as isobutane.

It should be noted that CN fails to teach that the deodorizer is used for identifying a leak and/or a fuel gas manufactures. However, intended use is given no patentable weight in claims that are directed to the composition per se. CN also fails to teach that the deodorizer burns without leaving a residue. However, it would be reasonable to expect that no residue of the deodorizer is left upon combustion of the fuel because one would expect that only a minute amount of the deodorize is used in the composition.

2. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1206039, as applied to the claims above, further in view of Yu (US 4,84,713).

CN has been discussed above. CN fails to teach the amount of fragrance used in the fuel composition or the particular fragrances. However, Yu teaches these differences.

Yu teaches fuel compositions containing deodorizers (fragrances) wherein the deodorizers are present in the composition in an amount from 0.05-10 parts per 100 parts fuels. Examples of the fragrances include bayberry, rose and lemon (see col. 2, lines 28-30, Examples 1-3).

It would have been obvious to one of ordinary skill in the art to have added the claimed fragrances to the fuel composition because CN especially desires a deodorizer

or fragrance and Yu teaches that the claimed fragrances produce odors produce fragrant odors in fuel compositions (see claim 1).

3. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant's arguments have been considered but are not deemed to be persuasive.

Applicant argues that CN uses the deodorizer of its invention for reducing or eliminating the odor of the fuel gas composition wherein the purpose of the fragrance in the present invention is to identify leaks and/or a specific fuel gas manufacturer.

CN teaches a fuel gas composition that may contain all of the claimed components in their recited proportions. CN teaches that the fuel gas composition may contain a deodorizer or fragrance. CN clearly teaches a fuel gas composition that is within the scope of the present fuel gas composition. While CN does not specific why it is using a deodorizer, it is well settled that the motivation of the prior art may be different from that of Applicant but still arrive at the same advantage or result as Applicant. *In re Linter*, 173 USPQ 560 (CCPA 1972).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

or fragrance and Yu teaches that the claimed fragrances produce odors produce fragrant odors in fuel compositions (see claim 1).

3. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant's arguments have been considered but are not deemed to be persuasive.

Applicant argues that CN uses the deodorizer of its invention for reducing or eliminating the odor of the fuel gas composition wherein the purpose of the fragrance in the present invention is to identify leaks and/or a specific fuel gas manufacturer.

CN teaches a fuel gas composition that may contain all of the claimed components in their recited proportions. CN teaches that the fuel gas composition may contain a deodorizer or fragrance. CN clearly teaches a fuel gas composition that is within the scope of the present fuel gas composition. While CN does not specific why it is using a deodorizer, it is well settled that the motivation of the prior art may be different from that of Applicant but still arrive at the same advantage or result as Applicant. *In re Linter*, 173 USPQ 560 (CCPA 1972).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).